Furthermore, please amend claim 13 as follows:

13. (Amended) The method of claim [12] 28, wherein said certain conditions under which the dealer is allowed to draw a single replacement card include when either three of the dealer's cards are equal in value or have a value between 5 and 10.

REMARKS

Claims 1-11 and 13-28 are now pending. Claims 1, 3-5, 11, 19, 20, 22-23, 26 and 27 are rejected under 35 U.S.C. § 103a as being anticipated by Potter et al., U.S. Patent No. 5,494,295. Claims 2, 6-10, and 13-18 were rejected under 35 U.S.C. §103(a) as obvious based on Potter in view of Shen, U.S. Patent No. 4,569,087. Claim 21 is rejected under 35 U.S.C. §103(a) as obvious based on Potter in view of Banyai, U.S. Patent No. 5,810,354. Claims 24 and 25 are rejected under 35 U.S.C. §103(a) as obvious based on Potter in view of Lo, U.S. Patent No. 5,863,042.

Applicant thanks the Examiner for extending the courtesy of a telephone interview on November 15, 2000. As discussed in the telephone interview, Applicant has introduced four new claims by amendment directed to a preferred embodiment of the invention. No new matter has been added to the application by this amendment.

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The Office Action was Improperly Made Final

As discussed in the telephone interview of November 15, Applicant respectfully request for the Examiner to withdraw the outstanding Final Office Action and enter the above amendments because the action introduces a new ground of rejection that is neither necessitated by claim amendments nor based upon information disclosed in an information disclosure statement. MPEP 706.07(a). The prior Office Action of March 7, 2000, rejected all claims as being rendered obvious by Breeding, U.S. Patent No. 5,248,142 either alone or in combination with several other secondary references. As stated above, the current Office Action now rejects all claims based at least in part upon Potter and does not rely at all upon Breeding. For these reasons, the Applicant respectfully submits that the outstanding Office Action is an improper Final Action as it relies upon a new ground of rejection, and thereby requests entrance and favorable consideration of the above amendments.

The Claims Are Not Anticipated or Made Obvious by Potter

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Claims 1, 3-5, 11, 19 and 20

Applicant's invention is a game is in which both the dealer and each player receive a set of cards of an equal number, and the players and dealer each split their cards into two half-hands. See Claim 1, lines 14-20. In order to win, the player's lowest hand must be lower than the dealer's lowest hand, and the player's highest hand must be higher than the dealer's highest hand. See claim 1, lines 21-24.

Potter, in contrast, describes a game in which the dealer possesses two hands while each player possesses only one. The player then decides whether to wager that his one hand will be higher than the dealer's highest hand, or lower than the dealer's lowest hand.

Thus, it is clear that the claimed invention is fundamentally different from that disclosed by Potter. In Potter, the player receives only one hand, while in applicant's invention, the player receives two. Furthermore, in Potter, the player chooses which of the dealer's hands to play against, while in applicant's invention, the player must defeat both the dealer's hands as claimed.

Because in Applicant's invention the player must

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play two half-hands and must win both hands against the dealer's two half-hands, Potter is not anticipatory. Therefore, Applicant respectfully requests that the rejection based on 35 U.S.C. §102(b) citing Potter must be withdrawn, and submits that claim 1 is allowable.

Furthermore, because claim 1 is allowable due to the above reasons, all other claims rejected as being anticipated by Potter that depend from claim 1 are also allowable. Therefore, Applicant respectfully requests favorable reconsideration.

Claims 22, 23, and 26-27

The rejection to independent claim 22 must also be withdrawn as the cited reference does not contain all elements of the applicant's invention.

The game apparatus as claimed comprises a table with a central dealer area. At this dealer area, indicia are printed on the table surface designating a HIGH half-hand region and a LOW half-hand region. This aids the players to quickly recognize which of the dealer's hands is designated the high hand and which is designated the low hand, which improves the speed and ease of the game, as well as player enjoyment.

There are no such indicia taught by Potter. The only elements taught by Potter at the dealer area are a

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chip tray 20 and the collection slot 22. See column 3, lines 3-6.

Because the claims contain elements not contained in Potter, Applicant respectfully requests that the rejection based on 35 U.S.C. §102(b) be withdrawn. Furthermore, all claims depending from claim 22 are likewise allowable because independent claim 22 is allowable.

Claims 2, 6-10 and 13-18

All rejections based on Potter in view of Shen, Banyai, Lo, and/or Malek must be withdrawn because the addition of these secondary references does not cure the deficiencies of Potter described above, nor are any of such references properly combinable with Potter. As previously demonstrated, the independent claims (claims 1 and 22) are allowable. The addition of the secondary references to the dependent claims does not remedy the above-described inadequacies of Potter.

Furthermore, the Shen, Banyai, Lo and Malek references are not properly combinable with Potter because Potter, as mentioned above, discloses a game in which the dealer receives two hands while the player receives one. The player must then choose which of the hands to play against. Shen and Lo disclose different

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games in which both the player and the dealer receive two hands. Unlike the claimed invention, Shen discloses splitting four card hands into two "HIGH" groups and Lo discloses a game limited to hands of no less than four cards by virtue of the scoring method disclosed in Lo. There is no motivation to combine these dissimilar games.

Furthermore, there is no suggestion in Potter that the player may have two hands, or to use the high/low scoring as is claimed. There is also no suggestion in Potter that the player must defeat both the hands of the dealer.

Additionally, Potter further discloses a game primarily based on poker. Banyai discloses a modified poker game. Malek describes a combination 21 and baccarat game. These games, while based upon playing cards, have fundamentally different premises and thus are not combinable to produce the claimed high/low game of this application.

In sum, the secondary references all disclose games different from the claimed invention. Moreover, the addition of the secondary references does not cure the deficiencies of Potter. There is no suggestion to combine Potter and the secondary references. The

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rejections based on Potter under 35 U.S.C. 103(a) must, therefore, be withdrawn.

The Claims Are Not Obvious in light of Breeding

While Breeding et al is not currently prior art asserted against the present application, the Office Action nonetheless argues that Breeding teaches the presently claimed invention having a different winning scheme. In Applicant's June 5, 2000, Request for Reconsideration, it was argued that the November 15 "Office Action asserts that Applicant's invention is "conventional Asian or Pai Gow poker as shown in Breeding... The only difference is how the players are declared the winner.' The Office Action then attempts to explain that one of ordinary skill in the art would be able to change the winning scheme of Breeding to produce the present invention without being inventive." In answer to this argument, the August 15 Office Action states that a "winning scheme is nothing more than a predetermine[d] criteria that must be met by a player in order to [be] considered a winner . . . [and while] a change in design may make the games different, the games may not be patentably distinct."

The "winning scheme" as claimed in the present

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invention is patentably distinct from that disclosed by Breeding. First, Breeding only discloses a game based on poker scoring. The present invention is in no way limited to such scoring as the specification makes clear that the invention can utilize poker-based scoring, or scoring based on adding the values of the cards.

Furthermore, Breeding discloses the traditional game of Pai Gow poker wherein each of the game's players is dealt seven cards. The seven cards are then divided by each player into two hands, one having 5 and the other 2 cards. Breeding does not teach or suggest any variation of this dealing and playing methodology. In fact, this methodology is necessitated due to the poker-based scoring method (i.e., one five card poker hand must be generated from the seven dealt cards) used in the game. The claimed invention does not have the players dividing the dealt cards into separate hands of five and two. In the Applicant's invention as claimed, the requirement is that the player split at least three of their cards into two half-hands. As properly defined by example in the specification[1], a half-hand

[1] The Office Action states that "[n]owhere in the claims does in [sic] recite that these hands are of equal amount [and no] such limitations will be read into the claims from the specification." Applicant is not

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is comprised of essentially equal amount of cards (3 and 3, 2 and 2, 2 and 3, or 1 and 2). Thus, nowhere does Breeding disclose, teach, or suggest to one of ordinary skill in the art a card based game method whereby two half-hands are created by each player and the dealer from an initial deal comprising 3 to 7 cards.

The Secondary References are Not Combinable

Applicant respectfully submits that all rejections based on Breeding in view of Malek, Banyai, and Lo must be withdrawn because the addition of these secondary references does not cure the deficiencies of Breeding described above. As demonstrated, the independent claims 1 and 22 are allowable because the prior art does not teach or suggest a game method comprising dealing 3 to 7 cards and then splitting those cards into high and low half-hands, or teach or suggest a game apparatus comprising dealer and player areas each having high half-hand and low half-hand regions. The addition of the secondary references to the dependent claims does not remedy the above-described inadequacies of Breeding. Furthermore, Applicant respectfully

asking for the Examiner to "read in" limitations into the claims, but rather is attempting to explain that the proper meaning of "half-hand" necessarily excludes splitting seven cards into one hand of 5 cards and a

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submits that the Malek reference is not properly combinable with Breeding.

Claims 13 and 28 are Allowable

As discussed in the telephone conference of November 15, new claim 28 has been introduced to rewrite claim 12 into independent format, and claim 13 has been amended to now recite dependency from claim 28. It is respectfully submitted that no prior art cited by the Examiner teaches the invention as recited in claim 28.

In rejecting now cancelled claim 12, the Office Action asserts that Malek teaches paying for an extra card to better one's hand and thus would lead one of ordinary skill in the art to modify the method of Breeding to achieve the claimed invention.

First, Applicant respectfully submits that Malek and Breeding are not combinable because they are very distinct games. As discussed above, Breeding is simply a traditional Pai Gow poker game (a game type in which card drawing is not allowed) wherein players two hands of 2 and 5 cards from an initial deal of 7 cards. Malek is a combination 21 and baccarat game (two game

second hand of two cards.

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types in which drawing additional cards is commonplace). There is no teaching or suggestion in either disclosure that card drawing elements employed in the Malek game could be combined into the very different game type disclosed in Breeding.

Additionally, the Applicant further notes that claim 28 recites that the dealer is allowed to draw a single replacement card under particular circumstances, and claim 13 continues on to define those circumstances. Nowhere does the combination of Breeding and Malek (or Potter and Malek) disclose this element of the invention as claimed.

Furthermore, it is noted that in light of the above comments with respect to claim 1, even if the two references could be properly combined the Applicant's claimed invention would not be rendered obvious. In and of itself, the method of dealing 4 cards, and then producing two half-hands from the cards dealt is in no way taught or suggested by any references alone or in combination cited by the Examiner during the examination of this Application. Thus, allowance of claims 28 and 13 is respectfully requested.

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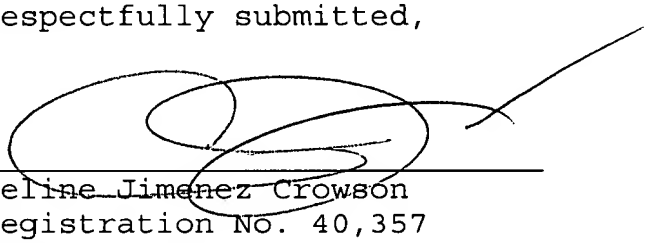
CONCLUSION

For all of the foregoing reasons, it is respectfully requested that the status of Office Action as Final be withdrawn, that the above amendments be entered, and that the rejections set forth in the Office Action be withdrawn. Claims 1-28 are allowable over the art of record, and the application is submitted to be in condition for immediate allowance. Favorable reconsideration of this application and a timely Notice of Allowance are respectfully requested.

Respectfully submitted,

By: 

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